



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/579,652

05/18/2006

Timothy A. Blizzard

21441YP

9359

210 7590 10/14/2008
MERCK AND CO., INC
P O BOX 2000
RAHWAY, NJ 07065-0907

EXAMINER

JEAN-LOUIS, SAMIRA JM

ART UNIT

PAPER NUMBER

1617

MAIL DATE

DELIVERY MODE

10/14/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/579,652	Applicant(s) BLIZZARD ET AL.	
	Examiner SAMIRA JEAN-LOUIS	Art Unit 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-10 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

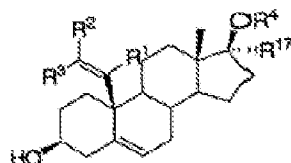
Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

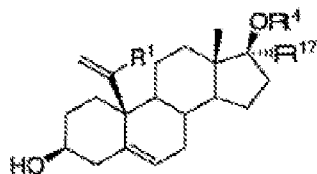
I. Group I, claims 1-6 and 8 are drawn to a method of treating a disease in a mammal in need thereof by administering to the mammal a therapeutically effective amount of a compound of the formula I,



II. Group II, claim 7 is drawn to a pharmaceutical composition comprising an agent selected from the list in claim 7 and a compound with the aforementioned formula in group I.

III. Group II, claims 9-10 are drawn to a compound with formula II,

Art Unit: 1617



II

with the proviso that R1 and R4 are not both hydrogen.

The inventions listed as Groups I, II and III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features.

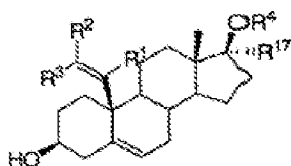
An international application should relate to only one invention or, if there is more than one invention, the inclusion of those inventions in one international application is only permitted if all inventions are so linked as to form a single general inventive concept (PCT Rule 13.1). With respect to a group of inventions claimed in an international application, unity of invention exists only when there is a technical relationship among the claimed inventions involving one or more of the same or corresponding special technical features.

The expression “special technical features” is defined in PCT Rule 13.2 as meaning those technical features that define a contribution which each of the inventions, considered as a whole, makes over the prior art. The determination is made on the contents of the claims as interpreted in light of the description and drawings. Whether or not any specific technical feature makes a “contribution” over the prior art,

Art Unit: 1617

and therefore constitutes a “special technical feature”, should be considered with respect to novelty and inventive step.

In this instant application, the common technical feature is purported to be the formula I,



This formula I cannot be said to be a special technical feature under PCT Rule 13.2 because the compound of formula II delineated in group III states a proviso wherein R¹ and R⁴ are not both hydrogen which automatically breaks unity among the three groups as the proviso is not applicable to all three groups. Moreover the aforementioned formula I, is shown in the prior art.

In this case, Bowers (U.S. Patent 3,102,127) teaches compounds of formula I where R¹ is H, R² and R² are H, R⁴ is H, and R¹⁷ is H, or lower alkyl, lower alkenyl, or lower alkynyl (see col. 1 and col. 7, claims 4-12). As a result, no special technical features exist among the different groups because the inventions in Groups I, II and III fail to make a contribution over the prior art with respect to novelty and inventive step. In conclusion, there is a lack of unity of inventions, and therefore restriction for examination purposes as indicated is proper.

Species Election

This application contains claims directed to more than one species of the generic invention. These species either possess divergent structures and/or chemical and physical properties. In addition, the instant application recites a plurality of diseases that possess different etiologies. Thus, these species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species listed below do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same special technical feature among the different species.

The species are as follows:

1) ***for Group I:***

a) Applicant is required to elect a particular compound of formula I delineated in claim 1. Alternatively, applicant may elect a particular compound listed in claim 6. Applicant is further required to provide both a name and corresponding structure of the elected compound.

b) Applicant is required to elect a particular disease to be treated with the method of group I. Alternatively, applicant may elect a particular disease listed in claim 1, 3, 4, or 5. In the event that applicant elects the disease of claim 5, applicant is further required to elect a particular type of estrogen dependent cancer to be treated in the method of group I.

c) The recitation of claim 8 indicates that the composition may further entail additional agent (s). Applicant is therefore required to elect the presence or absence of additional agent (s) . If the presence of additional agent (s) is elected, then applicant is further required to elect the particular agent (s) to be included in the composition listed in claim 8.

2) **for Group II:**

a) Applicant is required to elect a particular compound of formula I delineated in claim 7. Applicant is further required to provide both a name and corresponding structure of the elected compound.

b) Applicant is required to elect a particular agent to be combined with the compound of formula I delineated in claim 7. Alternatively, applicant may elect a particular agent listed in claim 7.

2) **for Group III:**

a) Applicant is required to elect a particular compound of formula II delineated in claim 9. Applicant is further required to provide both a name and corresponding structure of the elected compound.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims

Art Unit: 1617

subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The following claims 1-10 are generic.

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the

Art Unit: 1617

requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Applicant is also reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

No telephone call was made due to the complexity of the election/restriction.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samira Jean-Louis whose telephone number is 571-270-3503. The examiner can normally be reached on 7:30-5 PM EST M-Th.

Art Unit: 1617

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. J. L. /

Examiner, Art Unit 1617

10/03/08

/SREENI PADMANABHAN/

Supervisory Patent Examiner, Art Unit 1617